REMARKS

This is a full and timely response to the outstanding final Office Action mailed February 8, 2006 (Paper No/Date 20060203). Through this response, claims 1-29, 32-53 and 55 have been amended. Claim 57 has been newly added. Claims 1-57 are pending in the present Application. Reconsideration and allowance of the Application and pending claims are respectfully requested.

I. Claim Rejections – 35 U.S.C. § 103(a)

A. Rejection of Claims 1-13, 16-25, 27, 29-42, 45-49 and 51-56

Claims 1-13, 16-25, 27, 29-42, 45-49 and 51-56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,564,005 to Berstis, hereinafter referenced as *Berstis*, in view of U.S. Publication No. 2004/0128685 to Hassell *et al.*, hereinafter referenced as *Hassell*. Applicants respectfully traverse these rejections. Applicants have amended claims 1-29, 32-53 and 55, and thus the discussion below addresses the Office Action arguments in the context of the claim amendments.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, is respectfully asserted that a *prima facie* case for obviousness has not been established.

Independent Claim 1

Independent claim 1, as amended, recites:

> 1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
> a memory for storing recordable media content characterizing information;
> a storage device for storing a plurality of portable mediums; and
> a processor configured with the memory to:
> receive into the memory characterizing information corresponding to respective recordable media content;
> provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;
> download the first recordable media content via the subscriber network from a server responsive to a first user input selecting the first recordable media content from the user interface;
> ***determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content***; and
> store into at least one of the portable mediums the downloaded first recordable media content, the at least one of the portable mediums corresponding to the media type of the first recordable media content.

(Emphasis added.)

Applicants respectfully submit that the combination of *Berstis* and *Hassell* does not disclose, teach or suggest the emphasized features as highlighted in independent claim 1 above. More specifically, the combination of *Berstis* and *Hassell* does disclose, teach or suggest a processor configured to "determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content," as highlighted in the amended independent claim 1 above.

It is acknowledged in the Office Action that *Berstis* "fails to teach concurrently downloading and storing media into a removable medium." *Office Action, page 4.* However, it

is asserted in the Office Action that *Hassell* discloses "receiving and storing downloaded multimedia data onto a removable medium." *Office Action, page 2.* Specifically, *Hassell* discloses allowing "the user to transfer programs ... stored on digital storage device 49 to other volumes of digital storage device 49 or to secondary storage device 47...." *Hassell, paragraph 81, lines 1-4.* Further, *Hassell* discloses in paragraph 89:

> If the user indicates a desire to access a feature of the program guide which operates on a medium that is not currently loaded in digital storage device 49, the program guide may automatically change the loaded storage medium if digital storage device 49 has the ability to do so. Digital storage device 49 may be, for example, an optical jukebox with multiple recordable optical discs. ***If the user selects a program on a disc*** not currently positioned before a read/write head of the jukebox, the jukebox re-arranges the discs until the disc with the selected program is positioned for reading or writing. ***If the disc with the selected program*** is not in the jukebox, the program guide may display indication 255 to the user that the disc must be loaded.
>
> ***(Emphasis added.)***

And further, in paragraph 90, *Hassell* discloses:

> If digital storage device 49 uses removable storage media (e.g., floppy disks or recordable optical disks), ***the program guide may provide the user with the opportunity to enter an identifier that identifies the removable storage medium*** on which the program is stored. The identifier may be a volume name, a medium number, or other suitable unique indicator.
>
> ***(Emphasis added.)***

As indicated in the highlighted portions above, *Hassell* appears, *arguendo*, to teach transferring or recording programs to a disc or storage medium as identified by the respective program or the user. Utilizing a medium as selected by the user is not the same as making a determination as to a type of portable medium. Even if, *arguendo*, *Hassell* teaches the transfer of programs to a removable medium, there is no discussion of a processor configured to "determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content."

Thus the proposed combination of *Berstis* and *Hassell* fails to disclose, teach or suggest the features of independent claim 1. Because independent claim 1 is allowable over the proposed combination, dependent claims 2-13, 16-25, 27 and 29-31 are allowable as a matter of law for at least the reason that dependent claims 2-13, 16-25, 27 and 29-31 contain all elements of independent claim 1. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell* and that the rejection of these claims should be withdrawn.

Official Notice Regarding Dependent Claim 31

Additionally, regarding dependent claim 31, in order to support the Official Notice, the Examiner provides Applicant U.S. Patent No. 5,619,247 to Russo, hereinafter referenced as *Russo*. *Office Action, p. 12.* Applicants respectfully traverse this finding that the subject matter is well known. Particularly in the context of the claimed combination of "a similar processor, memory, and storage device located at the cable transmission facility (i.e., headend)," the subject matter alleged to be well-known is too specific and too complex for a reasonably skilled person to consider it to be well-known to the point that no additional evidence is needed.

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' dependent claim 31. Therefore, it is respectfully submitted that dependent claim 31 is patentable over *Berstis* in view of *Hassell* and that the rejection of this claim should be withdrawn.

Independent Claim 32

Independent claim 32, as amended, recites:

> 32. A method for archiving recordable media content in a subscriber network, comprising the steps of:
>
> receiving characterizing information corresponding to respective recordable media content;
>
> providing a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;
>
> downloading the first recordable media content responsive to a first user input selecting the first recordable media content from the user interface;
>
> ***determining a type of portable medium from a plurality of portable mediums for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content***; and
>
> storing into at least one of the portable mediums the downloaded first recordable media content, the at least one of the portable mediums corresponding to the media type of the first recordable media content.
>
> ***(Emphasis added.)***

Applicants respectfully submit that the combination of *Berstis* and *Hassell* does not disclose, teach or suggest the emphasized features as highlighted in independent claim 32 above. More specifically, the combination of *Berstis* and *Hassell* does disclose, teach or suggest "determining a type of portable medium from a plurality of portable mediums for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content," as highlighted in the amended independent claim 32 above.

It is acknowledged in the Office Action that *Berstis* "fails to teach concurrently downloading and storing media into a removable medium." *Office Action, page 4.*

As argued above, *Hassell* appears, *arguendo*, to teach transferring or recording programs to a disc or storage medium as identified by the respective program or the user. Utilizing a medium as selected by the user is not the same as making a determination as to a type of portable medium. Even if, *arguendo*, *Hassell* teaches the transfer of programs to a removable medium, there is no discussion regarding "determining a type of portable medium from a plurality of

portable mediums for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content."

Thus the proposed combination of *Berstis* and *Hassell* fails to disclose, teach or suggest the features of independent claim 32. Because independent claim 32 is allowable over the proposed combination, dependent claims 32-42, 45-49 and 51-56 are allowable as a matter of law for at least the reason that dependent claims 32-42, 45-49 and 51-56 contain all elements of independent claim 1. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell* and that the rejection of these claims should be withdrawn.

C. Rejection of Claims 14, 15, 28, 43 and 44

Claims 14, 15, 28, 43, and 44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berstis* in view of *Hassell* and further in view of WO 92/22983 to Browne, *et al.*, hereinafter referred to as *Browne*. Applicants respectfully traverse this rejection.

Dependent Claims 14, 15 and 28

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 1. *Browne* does not remedy the above-described deficiencies.

Browne appears, *arguendo*, to teach an "audio/video recorder system" and "reconfiguration of stored programs, and routing of stored programs to selected outputs." *Browne, Abstract.* There appears to be no discussion regarding the capability to "determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content," as recited in independent claim 1.

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 1. Because independent claim 1 is allowable over the proposed combination, dependent claims 14, 15 and 28 are allowable as a matter of law for at

least the reason that dependent claims 14, 15 and 28 contain all elements of independent claim 1. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

Dependent Claims 43 and 44

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 32. *Browne* does not remedy the above-described deficiencies.

Browne appears to teach an "audio/video recorder system" and "reconfiguration of stored programs, and routing of stored programs to selected outputs." *Browne, Abstract.* There appears to be no discussion regarding "determining a type of portable medium from a plurality of portable mediums for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content," as highlighted in the amended independent claim 32 above.

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 32. Because independent claim 32 is allowable over the proposed combination, dependent claims 43 and 44 are allowable as a matter of law for at least the reason that dependent claims 43 and 44 contain all elements of independent claim 32. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

D. Rejection of Claims 26 and 50

Claims 26 and 50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Berstis* in view of *Hassell*, and further in view of *Russo*. Applicants respectfully traverse this rejection.

Dependent Claim 26

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 1. *Russo* does not remedy the above-described deficiencies. More specifically, *Russo* does not disclose, teach or suggest a processor configured to "determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content," as recited in independent claim 1.

It is asserted in the Office Action that *Russo* discloses a "system whereby individual users have separate storage areas." Even if *Russo* discloses the asserted system, the above-described deficiencies of *Berstis* and *Hassell* are not remedied. There appears to be no discussion regarding the capability to "determine a type of portable medium for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content."

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 1. Because independent claim 1 is allowable over the proposed combination, dependent claim 26 is allowable as a matter of law for at least the reason that dependent claim 26 contains all elements of independent claim 1. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Russo*, and that the rejection of these claims should be withdrawn.

Dependent Claim 50

As described above, *Berstis* and *Hassell* do not disclose the features of independent claim 32. *Russo* does not remedy the above-described deficiencies. More specifically, *Russo* does not disclose, teach or suggest "determining a type of portable medium from a plurality of portable mediums for storing the downloaded first recordable media content, the type of portable medium

corresponding to a media type of the first recordable media content," as highlighted in the amended independent claim 32 above.

It is asserted in the Office Action that *Russo* discloses a "system whereby individual users have separate storage areas." Even if *Russo* discloses the asserted system, the above-described deficiencies of *Berstis* and *Hassell* are not remedied. There appears to be no discussion regarding regarding "determining a type of portable medium from a plurality of portable mediums for storing the downloaded first recordable media content, the type of portable medium corresponding to a media type of the first recordable media content."

Thus the proposed combination of *Berstis, Hassell* and *Browne* fails to disclose, teach or suggest the features of independent claim 32. Because independent claim 32 is allowable over the proposed combination, dependent claim 50 is allowable as a matter of law for at least the reason that dependent claim 26 contains all elements of independent claim 32. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In summary, it is Applicants' position that a *prima facie* case for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Berstis* in view of *Hassell*, and further in view of *Browne*, and that the rejection of these claims should be withdrawn.

II. New Claims

As identified above, claim 57 has been added into the application through this Response. Applicants respectfully submit that this new claim describes an invention novel and unobvious in view of the prior art of record and, therefore, respectfully request that this claim be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

Christopher D. Guinn
Registration No. 54,142

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500